

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:

George Fitzmaurice, et al.

Serial No. 10/748,685

Group Art Unit: 2174

Confirmation No. 1979

Filed: December 31, 2003

Examiner: Le V. Nguyen

For: A LAYER EDITOR SYSTEM FOR A PEN-BASED COMPUTER

**APPLICANT APPEAL BRIEF UNDER 37 C.F.R. §41.37**

**Mail Stop Appeal Brief-Patents**

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

In a Notice of Appeal filed February 16, 2010, the Applicant appealed from the Examiner's final Office Action rejecting claims 7-17.

Submitted herewith is an Applicant Appeal Brief under 37 C.F.R. § 41.37, and the requisite fees set forth in 37 C.F.R. §41.20(b)(2).

If any further fees are required in connection with this filing, please charge our Deposit Account No. 19-3935.

**TABLE OF CONTENTS**

- I. REAL PARTY IN INTEREST**
- II. RELATED APPEALS AND INTERFERENCES**
- III. STATUS OF CLAIMS**
- IV. STATUS OF AMENDMENTS**
- V. SUMMARY OF CLAIMED SUBJECT MATTER**
  - A. Independent Claim 8**
  - B. Independent Claim 17**
  - C. Dependent Claim 7**
  - D. Dependent Claim 9**
  - E. Dependent Claim 10**
  - F. Dependent Claim 11**
  - G. Dependent Claim 12**
  - H. Dependent Claim 13**
  - I. Dependent Claim 14**
  - J. Dependent Claim 15**
  - K. Dependent Claim 16**
- VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**
- VII. ARGUMENT**
  - A. Review of the Prior Art**
    - 1. Macromedia Flash**
    - 2. Bernstein**
    - 3. Buxton**
    - 4. Fox**
    - 5. Tosey**
    - 6. Decoste**

**B. Rejection of Claims 7-9 and 11-16 under 35 U.S.C. § 103(a) over Macromedia Flash, Bernstein, Buxton and Fox**

- 1. Independent Claim 8**
- 2. Dependent Claim 7**
- 3. Dependent Claim 9**
- 4. Dependent Claim 11**
- 5. Dependent Claim 12**
- 6. Dependent Claim 13**
- 7. Dependent Claim 14**
- 8. Dependent Claim 15**
- 9. Dependent Claim 16**

**C. Rejection of Claim 10 under 35 U.S.C. § 103(a) over Macromedia Flash, Bernstein, Buxton, Fox and Tosey**

**D. Rejection of Claim 17 under 35 U.S.C. § 103(a) over Macromedia Flash, Bernstein, Buxton, Fox, Tosey and Decoste**

**E. Summary**

**VIII. CLAIMS APPENDIX**

**IX. EVIDENCE APPENDIX**

**X. RELATED PROCEEDINGS APPENDIX**

**I. REAL PARTY IN INTEREST (37 C.F.R. § 41.37(c)(1)(i))**

The real party in interest is Autodesk, Inc. of San Rafael, California, the assignee of the subject application.

**II. RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 41.37(c)(1)(ii))**

Appellant, Appellant's legal representative, and the Assignee do not know of any prior or pending appeals, interferences or judicial proceedings, which may be related to, directly affect or be directly affected by, or have a bearing on, the Board's decision in this appeal.

**III. STATUS OF CLAIMS (37 C.F.R. § 41.37(c)(1)(iii))**

Claims 7-17 are rejected. Claims 7-17 are being appealed.

**IV. STATUS OF AMENDMENTS (37 C.F.R. § 41.37(c)(1)(iv))**

The Amendment, filed July 17, 2009 subsequent to the Office Action mailed March 17 2009 with amendments to claims 8 and 17 has been entered. No amendment was filed in response to the final Office Action mailed November 13, 2009.

## V. SUMMARY OF CLAIMED SUBJECT MATTER (37 C.F.R. § 41.37(c)(1)(v))

The independent claims being appealed are 8 and 17.

The dependent claims being appealed are 7 and 9-16.

### A. Independent Claim 8

8. (previously presented) An interface, comprising:

**Support:** See, for example, the present Application, paragraph [0023] and FIG. 1, reference numeral 10.

layer representation graphic having layer names inputable by a user and displayable as hand drawn strokes; and

**Support:** See, for example, the present Application, paragraphs [0023], [0030], FIG. 1 and FIG. 3, reference numerals 10, 12 and 80.

a control associated with the graphic that allows a corresponding layer to be edited by hand drawn gestures wherein the graphic has target areas with target sizes of greater than  $2e$  where  $e$  is a distance error accuracy of an input device.

**Support:** See, for example, the present Application, paragraph [0023], [0025] and FIG. 2, reference numerals 10, 12 and 50.

Independent claim 8 recites an interface. See, for example, the present Application, paragraph [0023] and FIG. 1, reference numeral 10.

The interface includes a layer representation graphic having layer names inputable by a user and displayable as hand drawn strokes. See, for example, the present Application, paragraphs [0023], [0030], FIG. 1 and FIG. 3, reference numerals 10, 12 and 80

The interface also includes a control associated with the graphic that allows a corresponding layer to be edited by hand drawn gestures wherein the graphic has target areas with target sizes of greater than  $2e$  where  $e$  is a distance error accuracy of an input device. See, for example, the present Application, paragraph [0023], [0025] and FIG. 2, reference numerals 10, 12 and 50.

### B. Independent Claim 17

17. (previously presented) A layer editor interface, comprising:

**Support:** See, for example, the present Application the present Application, paragraph [0023] and FIG. 1, reference numeral 10.

layer representation graphic having layer names inputable by a user and displayable as hand drawn strokes, and having selection



targets with a box shape, each selection box comprising:

**Support:** See, for example, the present Application, paragraphs [0023], [0030], FIG. 1 and FIG. 3, reference numerals 10, 12 and 80.

a marking menu control activatable for each layer that allows the layer to be edited by hand drawn gestures where the marking menu control comprises edit controls for new layer, clear layer, rename layer, delete layer, merge layer, lock layer, hide layer and position layer;

**Support:** See, for example, the present Application, paragraphs [0028], [0029] and FIG. 2, reference numerals 50, 52, 54, 56, 58, 60, 62 and 64.

a re-order layers control; and

**Support:** See, for example, the present Application, paragraph [0035] and FIG. 8, reference numerals 170, 174 and 176.

a layer opacity control having a dialog box with a slider for setting layer opacity,

**Support:** See, for example, the present Application, paragraph [0035] and FIG. 10, reference numerals 178 and 180.

wherein each of the controls has a target size of greater than  $2e$  where  $e$  is a distance error accuracy of an input device,

**Support:** See, for example, the present Application, paragraph [0023] and FIG. 1, reference numerals 10 and 12.

wherein an active layer is highlighted with a frame surrounding the name,

wherein each layer graphic has an indicator indicating whether a corresponding drawing layer is visible, and

wherein each layer graphic has an indicator indicating whether a corresponding drawing layer is locked.

**Support:** See, for example, the present Application, paragraph [0025] and FIG. 1, reference numerals 24, 26, 28 and 30.

Independent claim 17 recites a layer editor interface. See, for example, the present Application, paragraph [0023] and FIG. 1, reference numeral 10.

The layer editor interface includes layer representation graphic having layer names inputable by a user and displayable as hand drawn strokes, and having selection targets with a box shape. See, for example, the present Application, paragraphs [0023], [0030], FIG. 1 and FIG. 3, reference numerals 10, 12 and 80.

Each selection box includes a marking menu control activatable for each layer that allows

the layer to be edited by hand drawn gestures where the marking menu control comprises edit controls for new layer, clear layer, rename layer, delete layer, merge layer, lock layer, hide layer and position layer. See, for example, the present Application, paragraphs [0028], [0029] and FIG. 2, reference numerals 50, 52, 54, 56, 58, 60, 62 and 64.

The layer editor interface includes a re-order layers control and a layer opacity control having a dialog box with a slider for setting layer opacity. See, for example, the present Application, paragraph [0035], FIG. 8, FIG. 10, reference numerals 170, 174, 176, 178 and 180.

Each of the controls has a target size of greater than  $2e$  where  $e$  is a distance error accuracy of an input device. See, for example, the present Application, paragraph [0023] and FIG. 1, reference numerals 10 and 12.

An active layer is highlighted with a frame surrounding the name and each layer graphic has an indicator indicating whether a corresponding drawing layer is visible and has an indicator indicating whether a corresponding drawing layer is locked. See, for example, the present Application, paragraph [0025] and FIG. 1, reference numerals 24, 26, 28 and 30.

#### **C. Dependent Claim 7**

7. (previously presented) An interface as recited in claim 8, further comprising a drawing dialog box invoked by the control and allowing the user to input the layer names.

**Support:** See, for example, the present Application, paragraph [0030] and FIG. 3, reference numerals 80 and 82.

Claim 7 depends from claim 8 and recites a drawing dialog box invoked by the control and allowing the user to input the layer names. See, for example, the present Application, paragraph [0030] and FIG. 3, reference numerals 80 and 82.

#### **D. Dependent Claim 9**

9. (previously presented) An interface as recited in claim 8, wherein the control invokes a marking menu type layer editing menu.

**Support:** See, for example, the present Application, paragraph [0028] and FIG. 2, reference numeral 50.

Claim 9 depends from claim 8 and recites the control invokes a marking menu type layer editing menu. See, for example, the present Application, paragraph [0028] and FIG. 2, reference numeral 50.

#### **E. Dependent Claim 11**

11. (previously presented) An interface as recited in claim 8, wherein each layer control comprises:

a marking menu control for layer editing;

**Support:** See, for example, the present Application, paragraph [0028] and FIG. 2, reference numeral 50.

a move control for moving a position of a layer in a layer editor stack; and

**Support:** See, for example, the present Application, paragraph [0025], FIG. 1 and FIG. 8, reference numerals 36, 170, 174 and 176.

a transparency control controlling the transparency of a corresponding drawing layer.

**Support:** See, for example, the present Application, paragraph [0025], FIG. 1, FIG. 9 and FIG. 10, reference numerals 38, 172, 178 and 180.

Claim 11 depends from claim 8. Each layer control includes a marking menu control for layer editing. See, for example, the present Application, paragraph [0028] and FIG. 2, reference numeral 50.

Each layer control also includes a move control for moving a position of a layer in a layer editor stack. See, for example, the present Application, paragraph [0025], FIG. 1 and FIG. 8, reference numerals 36, 170, 174 and 176.

Finally, each layer control includes a transparency control controlling the transparency of a corresponding drawing layer. See, for example, the present Application, paragraph [0025], FIG. 1, FIG. 9 and FIG. 10, reference numerals 38, 172, 178 and 180.

#### F. Dependent Claim 12

12. (previously presented) An interface as recited in claim 8, wherein each layer graphic has an indicator indicating whether a corresponding drawing layer is hidden or visible.

**Support:** See, for example, the present Application, paragraph [0025], paragraph [0035], FIG. 1 and FIG. 11, reference numerals 30, 194 and 196.

Claim 12 depends from claim 8 and recites each layer graphic includes an indicator indicating whether a corresponding drawing layer is hidden or visible. See, for example, the present Application, paragraph [0025], [0035], FIG. 1 and FIG. 11 reference numerals 30, 194 and 196.

**G. Dependent Claim 13**

13. (previously presented) An interface as recited in claim 8, wherein each layer graphic has an indicator indicating whether a corresponding drawing layer is one of hidden and locked.

**Support:** See, for example, the present Application, paragraph [0025], paragraph [0035], FIG. 1 and FIG. 11, reference numerals 30, 194 and 196.

Claim 13 depends from claim 8 and recites each layer graphic includes an indicator indicating whether a corresponding drawing layer is one of hidden and locked. See, for example, the present Application, paragraph [0025], paragraph [0035], FIG. 1 and FIG. 11, reference numerals 30, 194 and 196.

**H. Dependent Claim 14**

14. (previously presented) An interface as recited in claim 8, wherein a background layer has a text label.

**Support:** See, for example, the present Application, paragraph [0025], [0035], FIG. 1 and FIG. 7, reference numerals 28 and 166.

Claim 14 depends from claim 8 and recites a background layer has a text label. See, for example, the present Application, paragraph [0025], [0035], FIG. 1 and FIG. 7, reference numerals 28 and 166.

**I. Dependent Claim 15**

15. (previously presented) An interface as recited in claim 8, wherein activation of each control via a mark simultaneously selects a corresponding layer and selects an operation on the layer.

**Support:** See, for example, the present Application, paragraph [0028] and FIG. 2, reference numeral 50.

Claim 15 depends from claim 8 and recites activation of each control via a mark simultaneously selects a corresponding layer and selects an operation on the layer. See, for example, the present Application, paragraph [0028] and FIG. 2, reference numeral 50.

**J. Dependent Claim 16**

16. (previously presented) An interface as recited in claim 8, wherein making a marking gesture in association with the layer representation graphic initiates a function with respect to one or more of the layers.

**Support:** See, for example, the present Application, paragraph [0039] and FIGS. 23-26, reference numerals 278, 280, 282, 284 and 286.

Claim 16 depends from claim 8 and recites making a marking gesture in association with the layer representation graphic initiates a function with respect to one or more of the layers.

See, for example, the present Application, paragraph [0039] and FIGS. 23-26, reference numerals 278, 280, 282, 284 and 286.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 7-9 and 11-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Screen Dumps of Macromedia Flash MX ("Macromedia Flash") in view of Bernstein et al. (U.S. Patent App. Pub. 2004/0093565), Buxton et al. (U.S. Patent No. 6,094,197) and Fox et al. (U.S. Patent App. Pub. 2002/0171690).

Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Screen Dumps of Macromedia Flash MX ("Macromedia Flash") in view of Bernstein et al. (U.S. Patent App. Pub. 2004/0093565), Buxton et al. (U.S. Patent No. 6,094,197), Fox et al. (U.S. Patent App. Pub. 2002/0171690) and Tosey (U.S. Patent App. Pub. 2004/0125153).

Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Screen Dumps of Macromedia Flash MX ("Macromedia Flash") in view of Bernstein et al. (U.S. Patent App. Pub. 2004/0093565), Buxton et al. (U.S. Patent No. 6,094,197), Fox et al. (U.S. Patent App. Pub. 2002/0171690), Tosey (U.S. Patent App. Pub. 2004/0125153) and Decoste et al. (U.S. Patent No. 6,317,142).

**VII. ARGUMENT (37 C.F.R. § 41.37(c)(1)(vii))**

**A. Review of the Prior Art**

**1. Macromedia Flash**

Macromedia Flash discusses layers which may be renamed by double clicking a name of a layer followed by entry of a name. A user may also rename a layer by right-clicking or Control-clicking the name of a layer, choosing properties, and entering a name. Macromedia Flash does not describe how a user enters a name. Macromedia Flash shows menu choices and icons which are associated with a Flash Timeline, but Macromedia Flash fails to describe all these menu choices and icons which have been numbered by the Examiner including 26, 30, 38, 40 and 50. Furthermore, the text on pages 1-3 of Macromedia Flash is not clearly linked to Figures 1-4.

**2. Bernstein**

Bernstein discusses a system and method for associating a handwritten title with a document note. Bernstein discusses that the handwritten title may be entered using a stylus based tablet computer system.

**3. Buxton**

Buxton discusses a graphical keyboard that accepts input responsive to different types of pen strokes. Buxton notes that a mark may provide a straightforward way to embed multiple command attributes to a single mark. Additionally, Buxton discusses that two different modes of selection of menu options including a selection using a menu mode and a selection using a mark mode.

**4. Fox**

Fox discusses a method and system for scaling the visual size of displayed widgets based on the proximity of a displayed selection pointer. Fox notes that as the selection pointer is moved toward or away from the widget, the widget changes in size. As seen in Figures 3A-3C of Fox, the size of the widget 21 is enlarged based on the distance D from a boundary B. Additionally, the selection pointer is snapped to a hot or selectable portion of a widget when the distance between the selection pointer and widget becomes less than the boundary B.

## **5. Tosey**

Tosey discusses focus in a graphical user interface as the ability to receive user input through an input device such as a mouse or keyboard. Figure 1 of Tosey shows a diagram having two command buttons. The command button "OK" in Figure 1 has focus.

## **6. Decoste**

Decoste discusses a system having a user interface for displaying a hierarchical organization. Additionally, the system is used to create and modify data of various types. Decoste discusses an opacity slider 210 and an accompanying text box 211. Decoste notes that this slider can be used to create strokes with fill having fill transparency.

### **B. Rejection of Claims 7-9 and 11-16 under 35 U.S.C. § 103(a) over Macromedia Flash, Bernstein, Buxton and Fox**

#### **1. Independent Claim 8**

Independent claim 8 recites an interface with a layer representation graphic having target areas with target sizes of greater than  $2e$  where  $e$  is a distance error accuracy of an input device. Claim 8 also recites a control associated with the graphic that allows a corresponding layer to be edited by hand drawn gestures.

First, with respect to the Office Action mailed November 13, 2009, Applicants are at a disadvantage for responding to the rejection because the Office has improperly shifted the burden onto the Applicant because the Office Action has failed to properly communicate a basis for the rejection. (See MPEP 706.02(j) and 2142). Macromedia Flash does not say that controls 38 and 40 are activatable to display a pop-up menu. The Office Action has made assertions regarding Macromedia Flash which are not corroborated by either the text or Figures.

Second, the Office Action noted on page 3 that Macromedia Flash, Bernstein and Buxton do not explicitly disclose the graphic having target areas with target sizes of greater than  $2e$  where  $e$  is a distance error accuracy of an input device. However, the Office Action, on page 3-4 asserted that Fox teaches "graphic having target areas with target sizes greater than  $2e$ ," which is a paraphrased version of the above features. The Office Action cited to Figures 3A-3C and paragraphs [0002], [0004] and [0036]-[0039] of Fox. In particular, the Office Action cited to



widget 21, physical pointer position 25, and boundary dimension 23. The Office Action asserted that "widget 21 has a target size greater than 2 times the distance error of the pointer to the widget for selection emphasis, i.e., as the physical pointer position 25 approaches target boundary dimension 23, which is approximately 2.5 widget distance from the widget to the pointer, the force field of the pointer snaps to the selectable portion of widget 21 and the widget expands its visual size to a boundary dimension 5 times its original size." The Office Action continued to assert that "[i]t would have been obvious to an artisan at the time of the invention to incorporate the method of Fox with the method of Macromedia Flash, Bernstein & Buxton in order to provide an improved GUI as available display real estate on a device shrinks with handheld portable devices and object presentation becomes more compact and a selection pointer tracking requires more manual dexterity and concentration on the user's part, especially in view of KSR, 127 S.Ct. 1727 at 1242, 82 USPQ2d at 1397 (2007)."

Fox, in paragraphs [0036]-[0039], discusses that the user positioned a real selection pointer to touch, but not cross, a boundary 23. When the user positions the real selection pointer to cross the boundary, the visually displayed position of the virtual selection pointer 24 snaps to the selectable portion of widget 21. The widget expands its visual size to the boundary. The real physical location of the actual pointer 25 has not changed, but rather the virtual selection pointer is attracted and positioned over the widget which has enlarged in size to the boundary. Thus, the user need not be as accurate in positioning the selection pointer.

However, in contrast to any teachings in Fox, claim 8 recites "the graphic has target areas with target sizes of greater than  $2e$  where  $e$  is a **distance error accuracy of an input device**." Fox discusses that widget 21 expands in size to a boundary based on the dimension  $D$ , a mass  $M$  of the real physical pointer, and widget's mass  $m$ . Nothing in Fox says that widget 21 "has target areas with target sizes of greater than  $2e$  where  $e$  is a distance error accuracy of an input device." The asserted changes in size of the widget in the Office Action appear to be merely estimates made by the Examiner without any support in Fox. Fox does not say that the drawings are to scale. MPEP 2125 specifically notes that "[w]hen the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value." (See MPEP 2125 and *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000).

Furthermore, the changes in size of the widget in Fox are not based on "a distance error accuracy of an input device." Rather, Fox only discusses in paragraph [0039] that the

enlargement of widget 21 is so that "[t]he user no longer need be as accurate in positioning the selection pointer." Fox fails to say that the change in size of widget 21 has any relation to distance error accuracy of an input device because Fox does not discuss a distance error accuracy of an input device. Rather, the Examiner has resorted to using impermissible hindsight to improperly contort the teachings of Fox to assert that the widgets in Fox are related to "a distance error accuracy of an input device" when Fox only discusses enlarging widgets based on problems of user accuracy and manual dexterity and not accuracy of an input device.

The Office Action's assertion on page 12 of the Office Action also improperly paraphrases claim 8. The Office Action asserted "Fox's teaching is consistent with both the specification and claim language that a target size be at least  $2e$  or twice as large as usual for ease of pointing." Claim 8 does not recite "ease of pointing." By making this assertion, the Office Action has further resorted to using impermissible hindsight. It is respectfully submitted that the Office Action's assertion that Fox's teaching is consistent with the Specification is irrelevant. The claims speak for themselves and should not be interpreted based on the Examiner's paraphrasing of the claims. Claim 8 recites "the graphic has target areas with target sizes of greater than  $2e$  where  $e$  is a distance error accuracy of an input device."

By making groundless estimates of changes in size of the widget 21 discussed in Fox and improperly paraphrasing the above features of claim 8, the Office Action has resorted to using impermissible hindsight. (See MPEP 2142.) In this particular case, the Office Action has failed to take into account only knowledge which would have been within the level of ordinary skill in the art at the time the claimed invention was made and gleaned knowledge from the applicant's disclosure in contrast to *In re McLaughlin*. (*In re McLaughlin*, 443 F.2d 1392, 170 U.S.P.Q. 209 (CCPA 1971). Thus, it would not have been obvious to one of ordinary skill in the art at the time of the invention, to combine Fox with Macromedia Flash, Bernstein and Buxton. In addition, the Office Action's assertion that "applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious" is traversed. As noted above, Fox does not say that widget 21 has a size which is based on "a distance error accuracy of an input device" but rather only "[t]he user no longer need be as accurate." Therefore, this advantage does not flow naturally from Fox and the Office Action's assertion based on *Ex parte Obiaya* is inapplicable. (See *Ex parte Obiaya*, 227 U.S.P.Q. 58, 60 (BPAI 1985)).

In conclusion, because the Office Action admitted that Macromedia Flash, Bernstein and

Buxton do not discuss "the graphic having target areas with target sizes of greater than  $2e$  where  $e$  is a distance error accuracy of an input device" and because Fox also does not teach these features it is respectfully submitted that claim 8 patentably distinguishes over Macromedia Flash, Bernstein, Buxton and Fox.

In addition, claim 8 recites "a control associated with the graphic that allows a corresponding layer to be edited by hand drawn gestures." The Office Action, on page 3, admitted that "Macromedia Flash and Bernstein do not explicitly disclose selections or operations with underlying menus such as applying an editing function to a layer." The Office Action then asserted "Buxton teaches selections or operations with underlying menus where a mark simultaneously selects a graphical representation and selects an operation on the graphical representation" and cited to Figure 11 and column 9, lines 27-28 and 56-57 of Buxton. Again, it is submitted that the claims speak for themselves and should not be interpreted based on the Examiner's paraphrasing of the claims. Buxton does not discuss allowing a corresponding layer to be edited by hand drawn gestures and does not discuss a control allowing a corresponding layer to be edited. Buxton, in Figure 11, merely shows selection which is made using a menu mode or a mark mode and does not describe a control allowing a corresponding layer to be edited. Therefore, the Office Action's reasoning to combine the teachings of Buxton with Macromedia Flash and Bernstein, "in order to provide a straightforward way to embed multiple command attributes into a single mark" fails to render "a control associated with the graphic that allows a corresponding layer to be edited by hand drawn gestures" obvious. As seen for example in Figure 2 of the Application, Buxton does not teach "a control associated with the graphic that allows a corresponding layer to be edited by hand drawn gestures."

Thus, independent claim 8 patentably distinguishes over Macromedia Flash, Bernstein, Buxton and Fox, taken alone and in combination.

## **2. Dependent Claim 7**

Dependent claim 7 is at least patentable due to its dependency from independent claim 8.

## **3. Dependent Claim 9**

Dependent claim 9 is at least patentable due to its dependency from independent claim 8.

#### **4. Dependent Claim 11**

Dependent claim 11 is at least patentable due to its dependency from independent claim 8. Dependent claim 11 also recites "a move control for moving a position of a layer in a layer editor stack; and a transparency control controlling the transparency of a corresponding drawing layer." The Office Action cited to Figures 2-4 of Macromedia Flash and asserted that Macromedia Flash discusses the above features. In particular, the Office Action asserted that "a move control for moving a position of a layer in a layer editor stack" is taught "via a drag operation in the timeline" and "a transparency control controlling the transparency of a corresponding drawing layer" is taught by "Windows > Panel > Effect." However, this is not discussed by the text of Macromedia Flash or shown in Figures 2-4. Therefore, Applicants are at a disadvantage for responding to the rejection because the Office has improperly shifted the burden onto the Applicant because the Office Action has failed to communicate a basis for the rejection. (See MPEP 706.02(j) and 2142).

It is submitted that claim 11 is independently patentable over Macromedia Flash, Bernstein, Buxton and Fox.

#### **5. Dependent Claim 12**

Dependent claim 12 is at least patentable due to its dependency from independent claim 8. Dependent claim 12 also recites "each layer graphic has an indicator indicating whether a corresponding drawing layer is hidden or visible." In particular, the Office Action has cited to Figures 2-4 of Macromedia Flash and asserted that indicators '.' in the eye icon column indicate that the layers are visible. However, this rejection has no support in the text of Macromedia Flash. Macromedia Flash and the Figures 2-4 do not corroborate this assertion. Therefore, Applicants are at a disadvantage for responding to the rejection because the Office has improperly shifted the burden onto the Applicant because the Office Action has failed to communicate a basis for the rejection. (See MPEP 706.02(j) and 2142). It is submitted that claim 12 is independently patentable over Macromedia Flash, Bernstein, Buxton and Fox.

#### **6. Dependent Claim 13**

Dependent claim 13 is at least patentable due to its dependency from independent claim 8. Dependent claim 13 also recites "each layer graphic has an indicator indicating whether a corresponding drawing layer is one of hidden and locked." In particular, the Office Action has cited to Figures 2-3 of Macromedia Flash and asserted that first "." indicator indicates that the

layers are visible, while "x" which is not shown indicates that the layers are hidden and second "." Indicates that the layers are unlocked, which a lock icon indicator not shown indicates that the layers are locked. As noted above, this rejection has no support in the text of Macromedia Flash. Furthermore, the Office Action has expressly admitted that relied upon teachings are not even shown in Figures 2-4. Therefore, Applicants are at a disadvantage for responding to the rejection because the Office has improperly shifted the burden onto the Applicant because the Office Action has failed to communicate a basis for the rejection. (See MPEP 706.02(j) and 2142). Therefore, it is submitted that claim 13 is independently patentable over Macromedia Flash, Bernstein, Buxton and Fox.

#### **7. Dependent Claim 14**

Dependent claim 14 is at least patentable due to its dependency from independent claim

8.

#### **8. Dependent Claim 15**

Dependent claim 15 is at least patentable due to its dependency from independent claim 8. Dependent claim 15 also recites "activation of each control via a mark simultaneously selects a corresponding layer and selects an operation on the layer." The Office Action, on page 6, cited to Figures 2-4 of Macromedia Flash, Figure 11 of Buxton and column 9, lines 27-28 and 56-57 of Buxton. The Office Action asserted that a click in Macromedia Flash selects a corresponding layer and that another click selects an operation on the layer. However, this rejection also has no express support in the text of Macromedia Flash. Therefore, Applicants are at a disadvantage for responding to the rejection because the Office has improperly shifted the burden onto the Applicant because the Office Action has failed to communicate a basis for the rejection. (See MPEP 706.02(j) and 2142).

Figure 11 of Buxton shows a mark and column, lines 26-27 discuss that marks provide a way to embed multiple command attributes into a single mark. The Office Action, however, fails to assert that it would have been obvious to combine the selection and operation, which supposedly require two clicks in Macromedia Flash into a mark. Therefore, it is respectfully submitted that claim 15 is independently patentable over Macromedia Flash, Bernstein, Buxton and Fox.

#### **9. Dependent Claim 16**

Dependent claim 16 is at least patentable due to its dependency from independent claim 8. Dependent claim 16 also recites "making a marking gesture in association with the layer representation graphic initiates a function with respect to one or more of the layers." In particular, the Office Action has cited to Figures 2-4 and pages 1-3, nearly all of Macromedia Flash, and paragraph [0039] of Bernstein. However, nothing in Macromedia Flash and Bernstein discusses making a marking gesture in association with the layer representation graphic initiates a function with respect to one or more of the layers. For example, a marking gesture as shown in Figure 24 of the Application could initiate a function to merge two layers. Neither reference teaches such a feature.

**C. Rejection of Claim 10 under 35 U.S.C. § 103(a) over Macromedia Flash, Bernstein, Buxton, Fox and Tosey**

Dependent claim 10 is at least patentable due to its dependency from independent claim 8.

**D. Rejection of Claim 17 under 35 U.S.C. § 103(a) over Macromedia Flash, Bernstein, Buxton, Fox, Tosey and Decoste**

Independent claim 17 recites a layer editor interface. Claim 17 also recites each of the controls has a target size of greater than  $2e$  where  $e$  is a distance error accuracy of an input device and a marking menu control activatable for each layer that allows the layer to be edited by hand drawn gestures.

First, as discussed above with respect to the Office Action mailed November 13, 2009, Applicants are at a disadvantage for responding to the rejection because the Office has improperly shifted the burden onto the Applicant because the Office Action has failed to properly communicate a basis for the rejection. (See MPEP 706.02(j) and 2142). Much if not all of the assertions regarding the asserted teachings of Macromedia Flash on pages 7-9 are not discussed or corroborated by Figures 2-4 or pages 1-3 of Macromedia Flash. As an example, page 9 expressly admitted that some of the asserted teachings are "not shown." Therefore, Macromedia Flash does not discuss or show "the marking menu control comprises edit controls for new layer, clear layer, rename layer, delete layer, merge layer, lock layer, hide layer and position layer." Furthermore, Applicants are at a disadvantage for responding to the rejection of the features including at least "the marking menu control comprises edit controls for new layer,

clear layer, rename layer, delete layer, merge layer, lock layer, hide layer and position layer."

Second, the Office Action noted on page 10 that claim 17 is rejected based on the same hindsight rationale as claim 8 discussed above. In particular, the Office Action on page 10 admitted that Macromedia Flash, Bernstein and Buxton do not disclose "the graphic having target areas with target sizes of at least  $2e$  where  $e$  is the distance error accuracy of an input device." However, the Office Action has paraphrased claim 17. It is submitted that the claims speak for themselves and should not be interpreted based on the Examiner's paraphrasing of the claims. Claim 17 recites "each of the controls has a target size of greater than  $2e$  where  $e$  is a distance error accuracy of an input device."

The Office Action on page 10 cited to pages 3 and 4 of Applicant's own specification and appears to have asserted that the above features are rejected based on Applicant's own specification as well as Figures 3A-3C of Fox along with paragraphs [0002], [0004], [0036]-[0039] of Fox. As noted above, the Office Action has rejected claim 17 based on impermissible hindsight by failing to only take into account knowledge which would have been within the level of ordinary skill in the art at the time the claimed invention was made and by admittedly gleaning knowledge from the applicant's disclosure. The Office Action has improperly contorted teachings from Fox as discussed above because Fox fails to discuss "the graphic having target areas with target sizes of at least  $2e$  where  $e$  is the distance error accuracy of an input device," and only discusses enlarging widgets based on user accuracy.

The Office Action has cited to widget 21 of Fox and asserted that "widget 21 has a target size greater than 2 times the distance error of the pointer to the widget for selection emphasis, i.e., as the physical pointer position 25 approaches target boundary dimension 23, which is approximately 2.5 widget distance from the widget to the pointer, the force field of the pointer snaps to the selectable portion of the widget and the widget expands its visual size to a boundary dimension 5 times its previous size." As noted above, these unsupported estimates made by the Examiner are of little value because even if the values are valid, Fox failed to state the drawings are to scale. (See MPEP 2125 and *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000)). In addition, Fox does not say that the size of widget 21 is "a target size of greater than  $2e$  where  $e$  is a distance error accuracy of an input device." Fox only notes in paragraph [0039] that widget 21 is enlarged in size to the boundary 23 B and the virtual selection pointer 24 is positioned directly on widget 21 when the selection pointer crosses boundary B.

Claim 17 further emphasizes "a marking menu control activatable for each layer that allows the layer to be edited by hand drawn gestures." The Office Action, on page 9, admitted that Macromedia Flash does not explicitly disclose input by a user that is displayable as hand drawn strokes. As noted above, the Office Action has failed to corroborate the asserted teachings of Macromedia Flash and Applicants are at a disadvantage for responding to the Office Action with respect to this feature.

The Office Action, also on page 9, admitted that Macromedia Flash and Bernstein do not explicitly disclose selections or operations with underlying menus such as applying an editing function to a layer. The Office Action cited to the Abstract and Figures 10 and 11 of Bernstein as curing the deficiencies of Macromedia Flash and Figure 11 and column 9, lines 27-28 of Buxton as curing the deficiencies of Macromedia Flash and Bernstein. However, the Office Action has paraphrased features of claim 17 and it is submitted that the claims speak for themselves and should not be interpreted based on the Examiner's paraphrasing of the claims.

Buxton does not discuss allowing the layer to be edited by hand drawn gestures. Buxton, in Figure 11, merely shows selection made using a menu mode or a mark mode and does not discuss allowing a layer to be edited by hand drawn gestures. Therefore, the Office Action's reasoning that "[i]t would have been obvious to an artisan at the time of the invention to incorporate the method of Buxton with the modified method of Macromedia Flash in order to provide a straightforward way to embed multiple command attributes into a single mark, especially in view of KSR, 127 S.Ct. 1727, at 1742, USP[Q]2d at 1397 (2007)" to combine Buxton with Bernstein and Macromedia Flash fails to render "a marking menu control activatable for each layer that allows the layer to be edited by hand drawn gestures" obvious.

Nothing cited or found in Tosey and Decoste cures the deficiencies of Macromedia Flash, Bernstein, Buxton and Fox discussed above.

Therefore, claim 17 patentably distinguishes over Macromedia Flash, Bernstein, Buxton, Fox, Tosey and Decoste.

## **E. Summary**

In view of the foregoing remarks, Appellant submits that pending appealed claims 7-17 are patentable over the relied upon cited references. Reversal of the Examiner's rejection is respectfully requested.



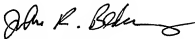
Serial No. 10/748,685  
Group Art Unit: 2174  
Examiner: Le V. Nguyen

The Commissioner is authorized to charge any Appeal Brief fee or Petition for Extension of Time fee for underpayment, or credit any overpayment, to Deposit Account No. 19-3935.

Respectfully submitted,

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**VIII. CLAIMS APPENDIX (37 C.F.R. § 41.37(c)(1)(viii))**

1.-6. (cancelled)

7. (previously presented) An interface as recited in claim 8, further comprising a drawing dialog box invoked by the control and allowing the user to input the layer names.

8. (previously presented) An interface, comprising:  
layer representation graphic having layer names inputable by a user and displayable as hand drawn strokes; and  
a control associated with the graphic that allows a corresponding layer to be edited by hand drawn gestures wherein the graphic has target areas with target sizes of greater than  $2e$  where  $e$  is a distance error accuracy of an input device.

9. (previously presented) An interface as recited in claim 8, wherein the control invokes a marking menu type layer editing menu.

10. (previously presented) An interface as recited in claim 8, wherein an active layer is highlighted with a frame surrounding the name.

11. (previously presented) An interface as recited in claim 8, wherein each layer control comprises:  
a marking menu control for layer editing;  
a move control for moving a position of a layer in a layer editor stack; and  
a transparency control controlling the transparency of a corresponding drawing layer.

12. (previously presented) An interface as recited in claim 8, wherein each layer graphic has an indicator indicating whether a corresponding drawing layer is hidden or visible.

13. (previously presented) An interface as recited in claim 8, wherein each layer graphic has an indicator indicating whether a corresponding drawing layer is one of hidden and locked.

14. (previously presented) An interface as recited in claim 8, wherein a background

layer has a text label.

15. (previously presented) An interface as recited in claim 8, wherein activation of each control via a mark simultaneously selects a corresponding layer and selects an operation on the layer.

16. (previously presented) An interface as recited in claim 8, wherein making a marking gesture in association with the layer representation graphic initiates a function with respect to one or more of the layers.

17. (previously presented) A layer editor interface, comprising:  
layer representation graphic having layer names inputable by a user and displayable as hand drawn strokes, and having selection targets with a box shape, each selection box comprising:  
a marking menu control activatable for each layer that allows the layer to be edited by hand drawn gestures where the marking menu control comprises edit controls for new layer, clear layer, rename layer, delete layer, merge layer, lock layer, hide layer and position layer;  
a re-order layers control; and  
a layer opacity control having a dialog box with a slider for setting layer opacity, wherein each of the controls has a target size of greater than  $2e$  where  $e$  is a distance error accuracy of an input device,  
wherein an active layer is highlighted with a frame surrounding the name,  
wherein each layer graphic has an indicator indicating whether a corresponding drawing layer is visible, and  
wherein each layer graphic has an indicator indicating whether a corresponding drawing layer is locked.

18-27. (cancelled)

**IX. EVIDENCE APPENDIX (37 C.F.R. § 41.37(c)(1)(ix))**

None

**X. RELATED PROCEEDINGS APPENDIX (37 C.F.R. § 41.37(c)(1)(x))**

None